

REMARKS

This is a request for continued examination (RCE) that includes the foregoing amendment and following remarks in response to the Final Office Action, dated August 29, 2008, and the Advisory Action, dated November 24, 2008. In the present Office Action, claims 1-47 stand rejected under 35 U.S.C. §102. By this response, reconsideration of the above-referenced patent application is respectfully requested.

Claims 1-47 remain pending. It is noted that the following claims have been amended without prejudice: 1, 3-4, 7-12, 21, 23-24, 26-27, 35, 37-39, and 44-47. It is noted that in many cases these claims have been amended to *remove* language. Nonetheless, Assignee reserves the right to amend these claims at a later time in prosecution, including to return such claims to their form as originally filed, for example. No claims have been cancelled or added.

In the Final Office Action, claims 1-47 are rejected under 35 USC § 102 as being anticipated by US Patent No. 6, 442,285 to Rhoads et al. (hereinafter “Rhoads”). In response, Assignee respectfully traverses this rejection of these claims. For at least the reasons set forth below, Assignee submits that claims 1-47 are not anticipated by Rhoads.

The Examiner is reminded that the Manual of Patent Examining Procedure (“MPEP”), in § 2131, states:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. V. Union Oil Co. California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Thus, under 35 U.S.C. § 102, a claim is anticipated *only if* each and every element of the claim is found in the cited document. Assignee believes that this standard is not met in this case.

We begin with claim 1, which we noted has been amended. It is respectfully asserted that Rhoads does not show or describe each and every element or limitation of claim 1, as amended. It now recites:

A method for delivering an asset over a network for integration with a content stream comprising:

supplying an asset list over said network to a user device;
delivering an asset, which is included in said asset list, over said network to said user device if a predetermined constraint is satisfied; and
integrating the delivered asset with said content stream.

Assignee has closely reviewed the Rhoads patent in its entirety and nowhere does that document describe integrating a delivered asset with a content stream. Rhoads does not appear to even be directed to the problem addressed by Assignee's claimed subject matter. Rhoads appears to be directed to watermarking which is a security related issue. It is, therefore, respectfully requested that the Examiner's rejection of claim 1 on this ground be withdrawn.

Likewise, claims 2 to 12 dependent from claim 1, as amended, and patentably distinguish from Rhoads on at least the same basis as claim 1. It is, therefore, respectfully requested that the Examiner's rejection of claims 2-12 on this ground also be withdrawn.

It is noted that independent claims 13, 26, 43, 44, 45, 46 and 47 contain limitations similar to claim 1 with respect to integration and, therefore, patentably distinguish from Rhoads at least on a similar basis as claim 1. Likewise, claims 14-25 and 27-42 depend from independent claims 13 and 26, respectively, and therefore patentably distinguish from Rhoads on at least the same basis as these claims. It is therefore respectfully requested that the Examiner withdraw his rejection of claims 13-47.

Assignee notes that it is believed that the rejected claims, 1-47, had been satisfactorily distinguished from Rhoads in previously filed office action responses; nonetheless, Assignee has provided additional reasons, as explained above, to distinguish the rejected claims from Rhoads. Therefore, there should now be no doubt that the pending claims patentably distinguish from Rhoads. It is therefore requested that the Examiner remove his claims rejections and permit the pending claims to proceed to issuance without delay.

Failure of the Assignee to respond to a position taken by the Examiner is not an indication of acceptance or acquiescence of the Examiner's position. It is believed that the Examiner's positions are rendered moot by the foregoing and, therefore, it is not necessary to respond to every position taken by the Examiner with which Assignee does not agree in

this or other correspondence. Instead, it is believed that the foregoing addresses the issues raised by the Examiner and that the present claims are in condition for allowance.

Conclusion

The foregoing is submitted as a response to the Final Office Action, dated August 29, 2008, and the Advisory Action, dated November 24, 2008. In view of the foregoing amendment and remarks, Assignee respectfully submits that pending claims are in condition for allowance and a notification of such allowance is respectfully requested.

If the Examiner believes that there are any remaining informalities that can be corrected by an Examiner's amendment, a telephone call to the undersigned at 503.439.6500 is respectfully solicited.

In the event there are any errors with respect to the fees for this response or any other papers related to this response, the Director is hereby given permission to charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account No. 50-3130.

Respectfully submitted,

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By



Howard A. Skaist, Patent Attorney
Registration No. 36,008

Customer No. 60226
c/o Berkeley Law & Technology Group,
LLP
17933 NW Evergreen Parkway, Suite
250
Beaverton, OR 97006
503.439.6500 (office)
503.439.6558 (fax)